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EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 09/23/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/602,305

Applicant(s)

FISK ET AL.

Examiner

Etienne P LeRoux

Art Unit

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9, 11-14, 16, 18, 21, 22 and 27-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-14, 16, 18, 21, 22 and 27-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18 and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

2. Claims 18 and 41 contain the trademark/trade name Gateway to Educational Materials Committee. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a gateway and, accordingly, the identification/description is indefinite.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2171

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 5, 7, 8, 11, 13, 21, 27, 29, 30, 33, 35 and 38 are rejected under 35

U.S.C. 102(e) as being anticipated by US Pat No 5,987,454 issued to Hobbs (hereafter Hobbs).

Claims 1, 7, 11 and 29:

Hobbs '454 discloses a method for creating an embedded search link document, comprising:

- accessing a genesis document
- performing a test search of a document source to identify test search results that satisfy a plurality of search parameters, in response to performing the test search, retrieving the test search results from the documents sources
- presenting the test search results to a user for a determination as to whether the test search results are desirable and in response to the determination that the test search results are desirable,
- embedding a search link corresponding to the search parameters into the genesis document to create the embedded search link document, the search link operative, when activated to initiate a search of the document source for search results that match the search parameters and to retrieve the search results [claim 29]

Claims 2 and 30:

Hobbs '454 discloses wherein a test search query based on the search parameters is formed for performing the test search of the document source further comprising compressing and storing the test search query as a portion of the genesis document so that activating the

Art Unit: 2171

search link causes the test search query to be accessed and used for performing the search of the document source [col 11, lines 1-11]

Claim 5:

Hobbs '454 discloses wherein the document source comprises a computer network [Fig 4].

Claims 8 and 33:

Hobbs '454 discloses the Internet [abstract].

Claim 13:

Hobbs '454 discloses HTML [col 10, lines 6-30]

Claims 21 and 38:

Hobbs '454 discloses a Boolean filter [col 1, line 61]

Claim 27:

Hobbs '454 discloses a computer readable medium having stored thereon computer executable instructions [abstract]

Claim 35:

Hobbs '454 discloses receiving the filtered test search results from the remote server via the communications device, designating at least one of the filtered test results as a preferred link, and compressing and storing as a portion of the genesis document a document URL corresponding to the preferred link [Fig 4]

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9, 14 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hobbs '454.

Claim 9:

Hobbs '454 discloses the elements of claim 8 as noted above.

Hobbs '454 fails to disclose accessing the genesis document comprises retrieving the genesis document from a remote location.

Official Notice is taken that accessing the genesis document comprises retrieving the genesis document from a remote location is well-known and expected in the art.

The ordinarily skilled artisan would have been motivated to modify Hobbs '454 as per the above for the purpose of improving the invention by accessing the document so that the user can modify the document as required.

Claims 14 and 37:

Hobbs '454 discloses the elements of claim 7 as noted above.

Hobbs '454 fails to disclose the preferred link is placed first within the search results.

Official Notice is taken that placing the preferred link first within the search results is well-known and expected in the art.

Art Unit: 2171

The ordinarily skilled artisan would have been motivated to modify Hobbs '454 as above for the purpose of quick and easy referencing of the preferred link

5. Claims 3, 4, 6, 12, 28, 31, 32, 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hobbs '454 in view of Pub No US 2001/0044833 issued to Eisendrath et al (hereafter Eisendrath '833).

Claims 3 and 31:

Hobbs '454 discloses the elements of claim 1 as noted above.

Hobbs '454 fails to disclose wherein the embedded search link document comprises an interactive lesson plan.

Eisendrath '833 discloses wherein the embedded search link document comprises an interactive lesson plan [abstract]

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hobbs '454 to include wherein the embedded search link document comprises an interactive lesson plan as taught by Eisendrath '833.

The ordinary skilled artisan would have been motivated to modify Hobbs '454 as above for the purpose of improving the invention by expanding the scope to include a virtual campus in which a learner can communicate with others.

Claims 4 and 32:

Hobbs '454 discloses the elements of claim 1 as noted above.

Hobbs '454 fails to disclose wherein the genesis document comprises a curriculum standards document.

Art Unit: 2171

Eisendrath '833 discloses wherein the genesis document comprises a curriculum standards document [paragraph 6]

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hobbs '454 to include wherein the genesis document comprises a curriculum standards document as taught by Eisendrath '833.

The ordinarily skilled artisan would have been motivated to modify Hobbs '454 as above for the purpose of improving the invention by making it easier for a student to select course material

Claims 6, 12, 34 and 36:

Hobbs '454 discloses the elements of claim 1 as noted above.

Hobbs '454 fails to disclose a site catalog.

Eisendrath '833 discloses a site catalog [paragraph 43]

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hobbs '454 to include a site catalog as taught by Eisendrath '833.

The ordinarily skilled artisan would have been motivated to modify Hobbs '454 as above for the purpose of improving the invention by making it easier for a student to select course material

Claim 28:

Hobbs '454 discloses a computer readable medium having stored thereon computer executable instructions [abstract]



Art Unit: 2171

6. Claims 16 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hobbs '454 and further in view of US Pat No 6,427,145 issued to Hara et al (hereafter Hara '145).

Claims 16 and 40:

Hobbs '454 discloses the elements of claim 1 as noted above.

Hobbs '454 fails to disclose wherein the search parameters relate to a subject, a topic, a minimum grade level and a maximum grade level.

Hara '145 discloses wherein the search parameters relate to a subject, a topic, a minimum grade level and a maximum grade level [col 5, lines 37-46]

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hobbs '454 to include wherein the search parameters relate to a subject, a topic, a minimum grade level and a maximum grade level as taught by Hara '145.

The ordinarily skilled artisan would have been motivated to modify Hobbs '454 as per the above for the purpose of obtaining a report concerning the progress of a student.

7. Claims 22 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hobbs '454 in view of US Pat No 5,321,833 issued to Chang et al (hereafter Chang '833).

Claims 22 and 39:

Hobbs '454 discloses the elements of claims 1, 7 and 21 as noted above.

Hobbs '454 fails to disclose wherein the Boolean filter classifies each of the search results based on the presence of positive words and negative words, positive words indicating that the search result corresponds to a particular context of the search parameter and negative

Art Unit: 2171

words indicating that the search result does not correspond to the particular context of the search parameter.

Chang '833 discloses wherein the Boolean filter classifies each of the search results based on the presence of positive words and negative words, positive words indicating that the search result corresponds to a particular context of the search parameter and negative words indicating that the search result does not correspond to the particular context of the search parameter [col 8, lines 15-27].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hobbs '454 to include wherein the Boolean filter classifies each of the search results based on the presence of positive words and negative words, positive words indicating that the search result corresponds to a particular context of the search parameter and negative words indicating that the search result does not correspond to the particular context of the search parameter as taught by Chang '833.

The ordinarily skilled artisan would have been motivated to modify Hobbs '454 as above for the purpose of ranking full text information retrieval systems with respect to their relevance to the terms of a query [col 2, lines 30-34].

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (703) 305-0620.

The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Etienne LeRoux

September 15, 2003



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